

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE

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AMPEX CORPORATION,

*Plaintiff,*

v.

EASTMAN KODAK COMPANY,  
ALTEK CORPORATION, and  
CHINON INDUSTRIES, INC.,

*Defendants.*

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) C.A. No. 04-1373 (KAJ)  
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**DECLARATION OF GABRIELLE E. HIGGINS IN SUPPORT OF AMPEX  
CORPORATION'S MOTION FOR SUMMARY JUDGMENT THAT THE  
QUANTEL PAINTBOX IS NOT PRIOR ART UNDER 35 U.S.C. §102 (a) and § 102(b)**

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Original Filing Date: May 23, 2006

Redacted Filing Date: May 31, 2006

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE

AMPEX CORPORATION,	)	
	)	
<i>Plaintiff,</i>	)	
	)	
v.	)	C.A. No. 04-1373-KAJ
	)	
EASTMAN KODAK COMPANY,	)	
ALTEK CORPORATION, and	)	
CHINON INDUSTRIES, INC.,	)	
	)	
<i>Defendants.</i>	)	

**DECLARATION OF GABRIELLE E. HIGGINS IN SUPPORT OF  
MOTION FOR SUMMARY JUDGMENT THAT THE QUANTEL PAINTBOX IS  
NOT PRIOR ART UNDER 35 U.S.C. § 102(a) AND § 102(b)**

I am counsel with the law firm of Ropes & Gray LLP, attorneys for plaintiff Ampex Corporation ("Ampex") in this action. I make this declaration in support of Ampex's Motion for Summary Judgment That the Quantel PaintBox is Not Prior Art Under 35 U.S.C. § 102(a) and § 102(b).

1. Attached hereto as Exhibit 1 is a true and correct copy of selected pages from the Initial Expert Report of Richard John Taylor, submitted in this action on March 24, 2006.

2. Attached hereto as Exhibit 2 is a true and correct copy of selected pages from the Supplemental Expert Report of Richard John Taylor, submitted in the ITC action on June 17, 2005.

3. Attached hereto as Exhibit 3 are selected pages from the Deposition of Richard J. Taylor, taken in the ITC action on June 6, 2005; selected pages

from the Deposition of Richard J. Taylor, taken in the ITC action on June 7, 2005; and selected pages from the Deposition of Richard J. Taylor, taken in this action on April 28, 2006.

4. Attached hereto as Exhibit 4 is a true and correct copy of a document produced by defendant Kodak, bearing Bates numbers EKC001001541-547.

5. Attached hereto as Exhibit 5 is a true and correct copy of a document entitled "Quantel DPB 7001 Paint Box User Guide," dated January 1983, and bearing Bates numbers EK002000467-537.

6. Attached hereto as Exhibit 6 is a true and correct copy of pages from the Quantel Limited DPB 7000/1 Operating and Service Manual, dated June 1984, and bearing Bates numbers EKC002001646, EKC002001685-689, EKC002001730, and EKC002001792.

7. Attached hereto as Exhibit 7 is a true and correct copy of selected pages from the Deposition of Martin A. Holbrook, taken in this action on March 10, 2006.

8. Attached hereto as Exhibit 8 is a true and correct copy of Complainant Ampex Corporation's Request to Respondent Eastman Kodak Company for Inspection and Testing of Certain Devices, filed in the ITC action on April 18, 2005.

9. Attached hereto as Exhibit 9 is a true and correct copy of a letter dated April 25, 2005 from Jordan L. Hirsch to Norman Beamer.

10. Attached hereto as Exhibit 10 is a true and correct copy of a letter dated April 29, 2005 from Norman H. Beamer to Jordan L. Hirsch.

11. Attached hereto as Exhibit 11 is a true and correct copy of a letter dated May 6, 2005 from Jordan L. Hirsch to Norman Beamer.

12. Attached hereto as Exhibit 12 is a true and correct copy of a draft brochure entitled "The PAINT BOX – Quantel's DPB 7000 Series Digital Paint Box," dated August 10, 1982 bearing Bates numbers EKC001018471-483.

13. Attached hereto as Exhibit 13 is a true and correct copy of an Ampex interoffice memo dated May 18, 1982.

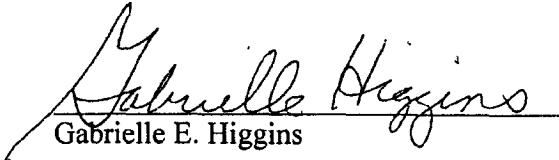
14. Attached hereto as Exhibit 14 is a true and correct copy of a document entitled "The Digital Video Report No. 12," dated September 1, 1982, and bearing Bates numbers EKC001030479-482.

15. Attached hereto as Exhibit 15 are true and correct copies of Weather Channel documents dated March, 1982, and bearing Bates numbers EKC002000538-539, EKC002000554-555.

16. Attached hereto as Exhibit 16 is a true and correct copy of a document entitled "PRELIMINARY DESCRIPTION – The Quantel DPB 7000 Digital Paint Box," dated March 22, 1982, and bearing Bates numbers AMP012388-393.

I declare under penalty of perjury that the foregoing is true and correct.

Executed on May 23, 2006 in Palo Alto, California.

  
Gabrielle E. Higgins

# EXHIBIT 1

Redacted

# EXHIBIT 2

Redacted



# EXHIBIT 3

Redacted

# EXHIBIT 4

Redacted

# EXHIBIT 5

Redacted

# EXHIBIT 6

Redacted



# EXHIBIT 7

VOLUME: I

PAGES: 1-115

EXHIBITS: 1-7

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE

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AMPEX CORPORATION,

Plaintiff,

v.

Civil Action

EASTMAN KODAK COMPANY, ALTEK

No. 04-1373-KAJ

CORPORATION and CHINON

INDUSTRIES, INC.,

Defendants.  
----- x

**CERTIFIED  
COPY**

DEPOSITION of MARTIN A. HOLBROOK

March 10, 2006

9:44 a.m.

Ropes & Gray LLP

One International Place

Boston, Massachusetts

Reporter: Michael D. O'Connor, RPR

MARTIN A. HOLBROOK March 10, 2006

1 portion of your question as vague.

2 A. I have not seen this document before.

3 Q. When were you first contacted in connection  
4 with -- you understand this is a patent infringement  
5 suit between Ampex and Kodak?

6 A. Yes.

7 Q. When were you first contacted concerning  
8 this lawsuit, to the best of your understanding?

9 A. In the autumn of last year.

10 Q. Who contacted you?

11 A. Mr. Summersgill and Ms. Grewal.

12 Q. Are they representing you, by the way, in  
13 connection with this matter?

14 MR. SUMMERSGILL: We are representing Mr.  
15 Holbrook for the purposes of his deposition, yes.

16 Q. Without going into the conversations, was  
17 it a telephone call?

18 A. A telephone call, yes.

19 Q. Did you have a meeting with them after  
20 that?

21 A. Yes.

22 Q. When was that?

23 A. I would suppose in November of last year.

24 Q. Was anyone else present besides the

MARTIN A. HOLBROOK March 10, 2006

1 attorneys that you mentioned?

2 A. My wife.

3 Q. Have you talked with Richard Taylor about  
4 this matter?

5 A. No. I haven't spoken to Richard Taylor for  
6 many years.

7 Q. When were you last at the Quantel facility?

8 A. I paid a cursory visit, a social call in, I  
9 suppose, approximately 1989.

10 Q. After the meeting you just spoke of with  
11 the attorneys, were there any subsequent meetings  
12 prior to today?

13 A. No.

14 Q. Where was the meeting?

15 A. The initial meeting?

16 Q. Yes.

17 A. In my house in France.

18 Q. So they got a trip to France out of it?

19 MR. SUMMERGILL: Objection.

20 Q. Any subsequent telephone calls?

21 A. Telephones and e-mails, simply to arrange  
22 this session today.

23 Q. Did you have a meeting recently prior to  
24 this deposition?

MARTIN A. HOLBROOK March 10, 2006

1 A. We've spoken in the last couple of days,  
2 yes.

3 Q. Meaning that you met at spoke?

4 A. I'm sorry?

5 Q. Meaning that you met and had a meeting or  
6 what?

7 A. Here in Boston.

8 Q. Did you review documents?

9 A. We did.

10 Q. Do you recall which documents you reviewed?

11 A. Mainly internal memoranda and sales  
12 documents from Quantel and MCI. And furthermore, I  
13 should add, the operator's guide for the Paint Box  
14 system.

15 MR. SUMMERGILL: Mr. Beamer, I can clarify  
16 for you that all of the documents that Mr. Holbrook  
17 was shown have been produced to you.

18 Q. Did you review a tape or other recording of  
19 a demonstration?

20 A. I saw a short tape, yes.

21 Q. Turning back to Page 8 of Exhibit 1, in the  
22 second paragraph under this Quantel Paint Box  
23 heading, it says, "The weather channel in Atlanta,  
24 Georgia purchased the Quantel Paint Box on March 8,

MARTIN A. HOLBROOK March 10, 2006

1 that Mr. Holbrook's deposition can proceed with the  
2 necessity of him presenting identification. Is that  
3 sufficient?

4 MR. SUMMERSGILL: Yes.

5 (Recess)

6 BY MR. BEAMER:

7 Q. On Exhibit 1, Page 9, I think it's the  
8 fourth sentence, the fourth and fifth sentence in  
9 the first full paragraph, it says, "The Paint Box  
10 could selectively generate a reduced-sized image.  
11 At the user's option, the full-sized image could be  
12 transferred from the disk data buffer directly to  
13 the size reducer."

14 Are you sufficiently familiar with the  
15 Paint Box circuitry to verify this statement?

16 MR. SUMMERSGILL: Objection. Compound.

17 A. I'm not technically minded.

18 Q. So you would not be able to say where in  
19 memory or on disk a particular image is stored at a  
20 particular point in time in the operation of the  
21 Paint Box?

22 A. You would be correct in saying that, yes.

23 MR. SUMMERSGILL: Mr. Beamer, I just want  
24 to clarify you're asking him about the fifth

MARTIN A. HOLBROOK March 10, 2006

1 sentence, because you read two sentences, and then  
2 asked him a question about one statement?

3 MR. BEAMER: I was focusing on the fifth  
4 sentence, yes.

5 MR. SUMMERSGILL: Okay.

6 A. Which sentence is that?

7 Q. The sentence that says, "At the user's  
8 option, the full-sized image could be transferred  
9 from the disk data buffer directly to the size  
10 reducer."

11 A. That would smack of technical terminology  
12 to me.

13 Q. Were you familiar at all with the circuitry  
14 or software of the Paint Box?

15 A. Absolutely not.

16 Q. When you worked with the engineers, did you  
17 ever get into any details about architecture of the  
18 Paint Box or algorithms for reducing the size of the  
19 image, anything of that nature?

20 MR. SUMMERSGILL: Objection.

21 A. I didn't get involved in that sort of  
22 detailed technology. My interest was solely to  
23 ensure that the user actually was not involved in  
24 that sort of technology. It was not necessary for

MARTIN A. HOLBROOK March 10, 2006

1 the user to know this or should not be necessary for  
2 a designer using the system to know this.

3 Q. Were you familiar with something called  
4 auto numbering in the context of saving and naming a  
5 picture?

6 A. That, I believe, is possible, yes.

7 Q. What's your understanding of what that  
8 refers to?

9 A. I think it refers to the ability to store  
10 images or parts of images in sequence, the machine  
11 numbering as you go, as you store.

12 Q. When was that feature first implemented in  
13 Paint Box?

14 A. I should imagine it was, from my memory,  
15 probably have been in January of '82.

16 Q. Do you remember that feature actually in  
17 use, say, at NAB '82?

18 A. I don't think I personally used it.

19 Q. Do you know whether it was actually  
20 available for use in NAB '82, in that model that was  
21 at NAB '82?

22 MR. SUMMERGILL: Objection. Asked and  
23 answered.

24 A. After this period of time, I couldn't be



MARTIN A. HOLBROOK March 10, 2006

1 system. This actually has been formalized in this  
2 new menu.

3 Q. When was it first implemented? Does this  
4 help you pin that down any better?

5 A. This would be present in the NAB '82  
6 machine, but not formalized as a menu item.

7 Q. What do you base your answer on, that it  
8 would have been present? Did you discuss this with  
9 counsel during lunch, this issue?

10 MR. SUMMERSGILL: Objection. I instruct  
11 the witness not to answer that.

12 Q. Did you discuss your questions and answers  
13 during lunch?

14 A. We had a general --

15 MR. SUMMERSGILL: Objection. I instruct  
16 the witness not to answer.

17 Q. Let me play for you a video segment that's  
18 been provided to us by Kodak.

19 (Tape shown)

20 Q. Did you have anything to do with preparing  
21 this demonstration tape?

22 A. No.

23 Q. When did you first see it?

24 A. Yesterday, I believe.

MARTIN A. HOLBROOK March 10, 2006

1 corresponding numbers, right?

2 MR. SUMMERSGILL: Objection.

3 Q. Do you understand that's what was done  
4 here?

5 A. It appears to be what was done.

6 Q. So my question is, did you ever do that,  
7 that sequence of operations?

8 A. My answer was, no, I didn't.

9 Q. Do you see this green area of the menu,  
10 xpos, some number in the 200s, and so on?

11 A. I see that, yes.

12 Q. Is that what we were looking at in Exhibit  
13 6 on page -- actually, I think we were looking at  
14 Exhibit 5. Is that the same menu? Do you recognize  
15 that?

16 A. This appears to be the same menu  
17 substantially, yes.

18 Q. So in NAB '82, the demo model would not  
19 have shown this green portion of the menu, correct?

20 A. It would not have shown the green portion  
21 of the menu.

22 Q. And over here do you see there's a stick  
23 and a tack on the menu?

24 A. Yes.

MARTIN A. HOLBROOK March 10, 2006

1 Q. The tack item would not have been in the  
2 NAB '82 menu, correct?

3 A. Tack was not present with '82.

4 Q. So this tells you that this demonstration  
5 is done with software that was dated after NAB '82,  
6 correct?

7 A. Yes.

8 Q. And indeed, it was done some five years --  
9 software dated some five years after NAB '82,  
10 according to Exhibit 5, right?

11 MR. SUMMERSGILL: Objection.

12 A. I can't date it, because there are no dates  
13 on this document.

14 Q. It's some years after NAB '82 that these  
15 two items were added to the menu, correct?

16 A. Correct.

17 Q. You mentioned you were involved with the  
18 Graphic Paint Box. Let me hand you what was marked  
19 as Taylor Exhibit 23. Do you recognize this  
20 document?

21 A. No.

22 Q. Would this reference to high resolution  
23 Graphics Paint Box be what you had mentioned that  
24 you worked on towards the end of your tenure at

MARTIN A. HOLBROOK March 10, 2006

1 Q. For your shorter hourly demos, did you  
2 demonstrate the browsing of cutouts?

3 A. Oh, yes, most certainly.

4 Q. Did you demonstrate the saving of  
5 reduced-sized cutouts?

6 A. Yes. It was a sequence. You reduced the  
7 size, you make it a cutout, you store it to the  
8 disk, you can retrieve it by the browse or title.  
9 All of that was demonstrated.

10 Q. But you can't recall the specific nature of  
11 the demo as to what image was being reduced or  
12 saved; is that correct? I'm talking now about the  
13 hourly demo.

14 MR. SUMMERGILL: Objection.

15 A. I mean, for the short demo, the hourly demo  
16 we are talking, almost certainly the ball bearing  
17 image.

18 Q. So you're saying you saved the  
19 reduced-sized ball bearing after you created the  
20 image of the ball bearings orbiting one another?

21 A. As a demonstration piece, yes.

22 Q. In general, the term storing cutouts or  
23 retrieving cutouts or browsing cutouts, that's not  
24 necessarily referring to reduced-sized images, is

MARTIN A. HOLBROOK March 10, 2006

1 it?

2 MR. SUMMERSGILL: Objection. You can  
3 answer.

4 A. It's a fine point. It doesn't necessarily  
5 refer to it, but I'm absolutely certain that it was  
6 done, because it was fundamental to the way the  
7 system works.

8 Q. A cutout could be any portion of an image,  
9 right, whether it's reduced or enlarged or rotated  
10 or not?

11 A. You're quite right.

12 MR. BEAMER: Okay. That's all. Thanks.

13 MR. SUMMERSGILL: Just give me two minutes.  
14 I think I'm all set, but I want to consult with  
15 people who are smarter than I am.

16 (Short recess)

17 MR. SUMMERSGILL: I have nothing further.  
18 Thank you, Mr. Holbrook.

19 (Whereupon the deposition  
20 concluded at 1:59 p.m.)  
21  
22  
23  
24

# EXHIBIT 8

**UNITED STATES INTERNATIONAL TRADE COMMISSION  
WASHINGTON, D.C.  
Before the Honorable Robert L. Barton, Jr.  
Administrative Law Judge**

\_\_\_\_\_  
In the Matter of )  
)  
)

CERTAIN DIGITAL IMAGE )  
STORAGE AND RETRIEVAL )  
DEVICES )  
\_\_\_\_\_)

Investigation No. 337-TA-527

**COMPLAINANT AMPEX CORPORATION'S REQUEST TO  
RESPONDENT EASTMAN KODAK COMPANY  
FOR INSPECTION AND TESTING OF CERTAIN DEVICES**

Pursuant to 19 C.F.R. § 210.30, Complainant Ampex Corporation ("Ampex") serves its Request For Inspection And Testing Of Certain Devices on Respondent Eastman Kodak Company ("Kodak"), and requests that such request be answered in writing, within ten (10) days after service hereof, as mandated by 19 C.F.R. § 210.30(b)(2).

The obligation imposed by these requests is continuing and, if after answering these requests Kodak acquires any additional or corrective information called for by these requests, Kodak must serve upon Ampex amended or supplemental responses promptly after Kodak becomes aware of such knowledge or information pursuant to 19 C.F.R. § 210.27(c)(1).

**INSTRUCTIONS**

Ampex hereby incorporates by reference the Instructions set forth in its First and Second Set of Document Requests to Respondent Kodak (Nos. 1-77).

**DEFINITIONS**

Ampex hereby incorporates by reference the Definitions set forth in its First and Second Set of Document Requests to Respondent Kodak (Nos. 1-77).

**REQUEST FOR INSPECTION AND TESTING OF THINGS**

Ampex requests that on Monday, May 2, 2005, it be provided the opportunity to inspect, at the offices of Wilmer Cutler Pickering Hale and Dorr LLP, 399 Park Avenue New York, NY 10022, or at such other time and location as agreed upon by the parties, the Quantel Paintbox system demonstrated in the video produced by Kodak at EKC002001284, the Digital Library Store 6000 ("DLS 6000") system that Kodak or its experts intend to demonstrate at trial, and any other device that Kodak or any of its experts intend to demonstrate or rely upon at trial, including without limitation, the Quantel Intellect; Harris Still Store IRIS II; ADDA Still Store System; AVA; ADO; SuperPaint; and Aurora/100 system. Pursuant to 19 C.F.R. § 210.30(b)(1), Ampex requests that a person competent to operate each said device, designated by Kodak, be made available at the inspection, with knowledge of the operation of the devices offered for inspection, who shall perform the following acts in the presence of Ampex's representative:

Navigation of the Quantel Paintbox system's menus and sub-menus and commands instantiated thereby, including PASTE UP and LIBRARY; operation of commands within PASTE UP, including without limitation, "cut", "cut picture", "cut all", "cutout", "paste", "paste stat", "paste original", the adjustment of size using a joystick and using "paste stat", "tack" and "stick"; operation of commands within LIBRARY, including without limitation, "find", "find picture", "save", "save picture", "save cutout", "directory", "browse", "titles", "escape"; all of the operations performed and/or demonstrated in the video produced by Kodak at EKC002001284; and all operations upon which Kodak or any of its experts intend to demonstrate or rely upon at trial;

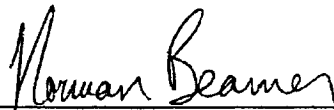
Navigation of DLS 6000 library, menus, and submenus; operations to store images on disc, including without limitation, the generation and storage of "composite pictures" (as described in a document produced by Kodak at EKC000141907); operations to size reduce images, including



without limitation, "picture compression"; the access of images from disc; display of images; display of 16 or 25 reduced size images at a time in browse, polyphoto, and/or any other mode; operation of the browse and/or polyphoto display, including storage and later recall of the browse and/or polyphoto display; and all operations upon which Kodak or any of its experts intend to demonstrate or rely upon at trial; and

For all other devices, all operations upon which Kodak or any of its experts intend to demonstrate or rely upon at trial.

Dated: April 18, 2005

  
\_\_\_\_\_  
Jesse J. Jenner  
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Ropes & Gray LLP  
1251 Avenue of the Americas  
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Barbara A. Murphy  
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Adduci, Mastriani & Schaumberg, L.L.P.  
1200 Seventeenth Street, N.W.  
Washington, D.C. 20036  
Phone No. (202) 467-6300

Attorneys for Complainant,  
Ampex Corporation

**CERTIFICATE OF SERVICE**

I hereby certify that the **COMPLAINANT AMPEX CORPORATION'S REQUEST TO RESPONDENT EASTMAN KODAK COMPANY FOR INSPECTION AND TESTING OF CERTAIN DEVICES** was served on this day as follows:

Michael D. Esch, Esq.  
Wilmer Cutler Pickering Hale and Dorr LLP  
1899 Pennsylvania Avenue, NW  
Washington, DC 20006

VIA E-MAIL  
(Extra copy to be sent via  
Federal Express for next-day  
delivery)

William P. DiSalvatore, Esq.  
Wilmer Cutler Pickering Hale and Dorr LLP  
399 Park Avenue  
New York, NY 10022

VIA E-MAIL copy by U.S. Mail

William F. Lee, Esq.  
Wilmer Cutler Pickering Hale and Dorr LLP  
60 State Street  
Boston, MA 02109

VIA E-MAIL copy by U.S. Mail

Erin Joffe, Esq.  
Office of Unfair Import Investigations  
U.S. International Trade Commission  
500 E Street, SW, Suite 401  
Washington, DC 20436

VIA E-MAIL  
(Extra copy to be sent via  
Federal Express for next-day  
delivery)

April 18, 2005

By \_\_\_\_\_  
Norman H. Beamer

# EXHIBIT 9

WILMER CUTLER PICKERING  
HALE AND DORR<sup>LLP</sup>

April 25, 2005

Norman Beamer  
Ropes & Gray LLP  
525 University Avenue  
Palo Alto, CA 94301

Jordan L. Hirsch

60 STATE STREET  
BOSTON, MA 02109  
+1 617 526 6330  
+1 617 526 5000 fax  
jordan.hirsch@wilmerhale.com

Re: Certain Digital Image Storage & Retrieval Devices,  
USITC Inv. No. 337-TA-527

Dear Mr. Beamer:

This letter is in reply to Ampex's April 18, 2005 Notice of Examination of Eastman Kodak Company and Request for Inspection and Testing of Certain Devices.

**The Notice of Examination**

Ampex asks Kodak to designate a witness with knowledge of the Quantel Paint Box, the Quantel DLS 6000, the Quantel Intellect, the Harris Still Store IRIS II, the ADDA Still Store System, Superpaint, and the Aurora/100 System. None of these prior art devices are Kodak devices or have ever been manufactured by Kodak. Respondents were able to identify these systems as prior art not through the knowledge of a Kodak employee but through the experts Kodak has identified throughout this Investigation. The only individuals Kodak can identify in response to this Notice of Examination have thus already been designated as experts. It is premature for Ampex to attempt to depose an expert as a fact witness before beginning expert depositions.

Nevertheless, Kodak does not seek to prevent Ampex from obtaining information relevant to the prior art systems. Kodak's experts provided lengthy and detailed reports detailing the functions of the prior art devices. The expert reports contained extensive claim charts comparing each of the prior art systems to the '121 Patent. Kodak also expects that Ampex will take depositions of the identified experts during the time set aside for expert discovery.

**The Request for Inspection and Testing of Certain Devices**

**The Quantel Paint Box**

On March 25, 2005, we submitted a video of the Paint Box along with the expert report of Richard Taylor. In Mr. Taylor's opinion, this video demonstrates all of the relevant features of the Paint Box. The Paint Box used to make the video is located at Quantel's headquarters in England. We do not have custody or control over the system and had to obtain Quantel's

BALTIMORE BEIJING BERLIN BOSTON BRUSSELS LONDON  
MUNICH NEW YORK NORTHERN VIRGINIA OXFORD WALTHAM WASHINGTON

April 25, 2005

Page 2

permission before making the video. If Ampex is willing to inspect the Paint Box in England, we will work with Quantel to arrange a date on which the Paint Box will be available.

*The Quantel DLS 6000*

Neither Respondents nor its experts have relied on a physical device in describing the DLS 6000. We do not have control or custody of a Quantel DLS 6000 system. We are aware of a DLS 6030 in the possession of CBS in New York, New York but to the best of our knowledge that system is not currently operational.

*The Quantel Intellect*

Neither Respondents nor its experts have relied on a physical device in describing the Quantel Intellect. We do not have possession or control of an Intellect system and we do not know if a system exists. We will consult with Quantel and let you know if Quantel possess a system available for inspection in England.

*The Harris Still Store IRIS II*

Neither Respondents nor its experts have relied on a physical device in describing the Harris Still Store IRIS II. We do not have possession or control of a Harris Still Store IRIS II and we do not know if a system exists.

*The ADDA Still Store System*

Neither Respondents nor its experts have relied on a physical device in describing the ADDA Still Store System. We do not have possession or control of an ADDA Still Store System and we do not know if a system exists.

*The AVA and ADO*

The AVA and ADO are systems manufactured by Ampex. We have no knowledge of the whereabouts or existence of an AVA or ADO system.

*Superpaint*

Neither Respondents nor its experts have relied on a physical device in describing Superpaint. We do not have possession or control of a Superpaint system but we have learned that the Computer Museum in California is in possession of a Superpaint machine.

*The Aurora/100 System*

Neither respondents nor its experts have relied on a physical device in describing the Aurora/100 System. We do not have possession or control of an Aurora/100 System and we do not know if a system exists.

April 25, 2005  
Page 3

As discovery proceeds, we will alert Ampex if we become aware of the existence or location of any prior art systems.

Sincerely yours,

A handwritten signature in black ink, appearing to read 'Jordan L. Hirsch', with a stylized, flowing script.

Jordan L. Hirsch

cc: Erin Joffre, Esq.  
Jesse J. Jenner, Esq.  
Barbara A. Murphy, Esq.

# EXHIBIT 10



ROPE & GRAY LLP

525 UNIVERSITY AVENUE SUITE 300 PALO ALTO, CA 94301-1917 650-617-4000 F 650-617-4090  
BOSTON NEW YORK PALO ALTO SAN FRANCISCO WASHINGTON, DC www.ropesgray.com

**NORMAN H. BEAMER**  
DIRECT DIAL 650.617.4030  
DIRECT FAX 650.566.4149  
E-MAIL NORMAN.BEAMER@ROPEGRAY.COM

April 29, 2005

**VIA EMAIL (CONF. BY MAIL)**

Jordan L. Hirsch, Esq.  
Wilmer Cutler Pickering Hale and Dorr LLP  
60 State Street  
Boston, MA 02109

*In the Matter of Certain Digital Image Storage and Retrieval Devices*  
Inv. No. 337-TA-527

Dear Mr. Hirsch:

This is in response to your letter of April 25, 2005, objecting to Ampex's deposition notice regarding the operation of prior art devices, and the accompanying request for inspection of those devices. This also addresses the related issue of scheduling expert depositions, and in therefore in part addresses Erin Joffre's letter of yesterday.

**Deposition Notice**

As a threshold matter, if your letter was intended as a unilateral refusal to comply with Ampex's discovery requests, we believe it was improper. Absent a protective order, or agreement by the parties, discovery requests cannot simply be ignored. By your letter, Respondents admit that their hired experts are knowledgeable about the subjects of the deposition notice. Yet Respondents apparently have refused to designate them or anyone else to testify on their behalf for this deposition.

We would prefer to view your letter in a more constructive light — as a request by Respondents for Ampex to reconsider its approach to discovery. Accordingly, Ampex first addresses your suggestion that Ampex ask the experts, at their expert depositions, questions about the alleged prior art devices, concerning which they apparently have factual information. Ampex does not consider this a suitable substitute for the noticed deposition of Kodak. However, Ampex



Jordan L. Hirsch, Esq.  
April 29, 2005  
Page 2

is willing to postpone without date the deposition, reserving the right if necessary to seek an order compelling that it go forward at some later date, provided Respondents agree to the following conditions:

- notwithstanding that the expert depositions will be held after fact discovery cutoff, Respondents will not object to factual questions as untimely;
- sufficient time will be allocated for each witness to cover both his factual knowledge and to conduct expert discovery; for example, the schedule should allow two days for at least the depositions of Mr. Taylor, Mr. Herot and Dr. Myers;
- Respondents will not object to Ampex's experts supplementing its experts' rebuttal reports to take into account any additional factual information that is uncovered at these depositions.

In any event, Ampex will reassess the situation after expert depositions, and if necessary move for appropriate relief.

#### **Inspection Of Alleged Prior Art Devices**

Ampex understands your letter to be in lieu of a formal written response to the April 18, 2005 Request for Inspection.

In his expert report, Mr. Taylor refers to a video that he prepared that purports to demonstrate the alleged Paintbox prior art (§ 57). He also states that he "may use at trial" a DLS6000 that he has access to (§ 75). If Respondents intend to use the tape or either device in any way at trial, then Ampex insists on an inspection in the United States before the due date of the rebuttal reports. It should not be necessary for Ampex's counsel or the ITC staff to travel to the United Kingdom to inspect these devices, given that Mr. Taylor has reserved the right to use those devices, or videos thereof, at the hearing. Your explanation that Quantel is in possession of these devices fails to take into account that Mr. Taylor is Executive Chairman of Quantel. If Respondents do not comply with this reasonable request, Ampex will seek to compel discovery and/or to preclude Respondents from relying on this alleged art.

Ampex understands your letter to be a representation that Respondents do not intend to demonstrate any of the other alleged prior art devices at the hearing, nor do they intend to make use of any videos of same, other than what has already been produced. For example, Superpaint will remain undisturbed in the Computer Museum in California. Please advise if this understanding is incorrect in any way. Also please note that Ampex reserves the right to object to the admissibility of such videos.

Jordan L. Hirsch, Esq.  
April 29, 2005  
Page 3

**Expert Deposition Scheduling**

Not counting Prof. Adelman, Respondents have designated ten experts, and Ampex three. At least four (Dr. Ligler and the three mentioned above) will require two days. In addition, Mr. Anderson has a long-scheduled trip outside of the country from May 26-June 10. Therefore, Ampex purposes that the parties seek leave of the Judge to extend the expert discovery period until June 17. Dr. Ligler is scheduled for June 1 and 2. We suggest Mr. Anderson for June 15, 16 or 17. We will check on Mr. Zaitlen's availability. Please provide suggested dates for Respondents' experts.

Very truly yours,

  
Norman H. Beamer

NHB:nhb

cc: William P. DiSalvatore, Esq.  
William F. Lee, Esq.  
Barbara A. Murphy, Esq.  
Erin D.E. Joffe, Investigative Attorney

# EXHIBIT 11

WILMER CUTLER PICKERING  
HALE AND DORR

May 6, 2005

Norman Beamer  
Ropes & Gray LLP  
525 University Avenue  
Palo Alto, CA 94301

Jordan L. Hirsch

60 STATE STREET  
BOSTON, MA 02109  
+1 617 526 6330  
+1 617 526 5000 fax  
jordan.hirsch@wilmerhale.com

Re: Certain Digital Image Storage & Retrieval Devices,  
USITC Inv. No. 337-TA-527

Dear Mr. Beamer:

This letter is in response to your April 29, 2005 letter regarding Ampex's request to depose individuals with knowledge of the prior art devices and Ampex's request to inspect the prior art devices.

**Deposition Notice**

We understand that Ampex does not intend to proceed with this deposition at this time, and that you will reassess whether you believe it is necessary after expert depositions. You have asked whether in return we will agree to three conditions. As to the conditions you suggest:

- We agree to not object during the expert depositions on the grounds that Ampex's questions are factual questions related to the prior art.
- We agree to not object to Ampex's attempts to supplement its experts' rebuttal reports with new factual information revealed during the course of the expert depositions so long as the supplementation is limited to *legitimately new factual information* revealed during the depositions.
- We can make Mr. Taylor, Mr. Herot and Dr. Myers available for one-day depositions but we do not agree to two-day depositions. As you know, Mr. Taylor, Mr. Herot, and Dr. Myers' reports are limited to issues relating to the validity and enforceability of Ampex's patent. Ampex has agreed to produce its expert on infringement *and* invalidity, Dr. Ligler, for a total of two days, one day for infringement and one day for invalidity. We believe the same limits should apply to both parties' experts – that is, that each of our experts testifying on issues relating to invalidity should be made available for one day as well. Moreover, we disagree with your suggestion that you need extra time to question the experts because you need to make factual inquiries regarding the features and capabilities of the prior art systems. The primary subject matters of their expert reports

BALTIMORE BEIJING BERLIN BOSTON BRUSSELS LONDON  
MUNICH NEW YORK NORTHERN VIRGINIA OXFORD WALTHAM WASHINGTON

May 6, 2005  
Page 2

are the features and capabilities of the prior art systems -- the expert and factual inquiries therefore overlap.

### **Inspection of Prior Art Devices**

#### *The Quantel Paint Box*

In my April 25, 2005 letter, I indicated that we were willing to make the Quantel Paint Box available for inspection at Quantel's headquarters in England. There are a number of reasons for making it available for inspection in England rather than shipping it to the United States at this time. First, the system was built in the early 1980s; it is a sensitive and fragile system, and there is a risk that shipping may render the system inoperable. Second, the cost of shipping is significant; the system would have to be disassembled, special crates would have to be made for transfer, and arrangements would have to be made with an appropriate carrier. Finally, the cost of reassembling the machine upon arrival in the United States is also significant. At least three Quantel engineers would have to travel with the machine in order to reassemble and reboot it upon arrival in the United States. We estimate the total cost of shipping to the United States and reassembly to be 25,000 Pounds Sterling (this does not include the cost of shipping the system back to England).

If we decide to use the actual Paint Box system at trial, rather than just the video demonstration we have already provided to you, we would ship the system at the time of trial, directly to the ITC, and we would ask Quantel engineers to come to the United States only once. Shipping and reassembling the system now would require moving the system twice and would require Quantel engineers to travel to the United States twice. As a result, shipping it now could double the costs and risks. Moreover, it would also require the Paint Box to remain in the U.S., out of Quantel's possession, for more than four months.

Considering the significant cost and risks, we believe the better and cheaper option is inspection in England. If Ampex nevertheless insists on inspecting the Paint Box in the United States now, we can arrange for the system to be shipped if Ampex is willing to bear the costs of the shipping and reassembly of the system for inspection. If we later decide to use the Paint Box at trial, we will be responsible for all further shipping and reassembly costs (to the ITC and then back to England). If we do not, Ampex will have to cover the costs of shipping the system back to England. In short, we will ask Quantel to ship the system to the United States for inspection now as long as Ampex agrees to pay all costs above and beyond what Kodak would be required to cover if it brought the system over for trial. Please let us know how you would like to proceed.

#### *The Quantel DLS6000*

In my April 25, 2005 letter I also referenced the DLS6030 system in the possession of CBS in New York, New York. While that system is not currently operational, it is possible that

May 6, 2005

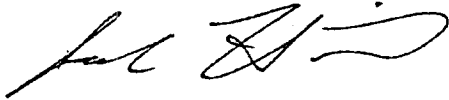
Page 3

Quantel engineers would be able to start the system for your inspection. If you are willing to pay to bring these engineers to New York, we can discuss this possibility further with Quantel.

*The Quantel Intellect, Harris Still Store IRIS II, ADDA Still Store, SuperPaint, Aurora, Ampex AVA and Ampex ADO*

As to the other prior art systems, your understanding that we do not currently intend to demonstrate the Quantel Intellect, Harris Still Store IRIS II, ADDA Still Store, SuperPaint or Aurora/100 systems is correct. We reserve the right to later decide to use one or more of these systems at trial and will inform Ampex if and when we do. We similarly reserve the right to use any videos of these systems at trial. As to the Ampex AVA and Ampex ADO, these are Ampex's own systems to which Ampex presumably has better access than does Kodak. We request therefore that Ampex make these systems available for Kodak's inspection. We similarly reserve the right to use AVA and ADO videos at trial.

Sincerely yours,

A handwritten signature in black ink, appearing to read "Jordan L. Hirsch", written in a cursive style.

Jordan L. Hirsch

cc: Erin Joffre, Esq.  
Jesse J. Jenner, Esq.  
Barbara A. Murphy, Esq.

# EXHIBIT 12

Redacted



# EXHIBIT 13

Redacted

# EXHIBIT 14

Redacted

# EXHIBIT 15

Redacted

# EXHIBIT 16

# MCI/QUANTEL

Micro Consultants, Inc., P.O. Box 50810, Palo Alto, California 94303, Phone: (415) 856-6226, Telex: 334420

March 22, 1982

## NEWS

### PRELIMINARY DESCRIPTION

#### The Quantel DPB 7000 Digital Paint Box

##### Introduction

Claims of 'breakthrough' and 'revolutionary approach' abound in the broadcast equipment industry, but when Quantel unveiled the DPB 7000 Digital Paint Box at NAB 1981, it was universally agreed that the machine did indeed represent a revolutionary approach to the electronic generation of graphics, and, in terms of the fidelity of the images produced was a genuine breakthrough.

##### The Paint Box - A Complete Graphics Studio

The Paint Box is a multifaceted tool able to fulfill all the requirements of the graphics studio: creating fine art free-hand drawing of quite breathtaking fidelity; retouching real video pictures; offering standard graphic routines for 'painting by numbers'; providing superb quality fonts for character generation; containing its own library of pictures; allowing composition of graphics by the assembly of several different pictures graphic primitives; repositioning, re-sizing and re-orientating those pictures; producing soft blending of images; building stencils; and allowing animation of portions of the pictures.

In fact the Paint Box does indeed offer all the tools normally found in a complete Graphics Studio in one machine.

##### The Paint Box - A Fine Art Device

Apart from the absence of a large computer, at first sight the DPB 7000 paint box hardware appears just like a first-generation paint system. There is a touch tablet on which to draw with a stylus, a screen to observe the results, a small box of electronics doing the work, and a Winchester disk storing a library of pictures.

AMP012388



When an artist starts to use the system, the differences between the Paint Box and first-generation equipment become quickly apparent. As he draws, the lines created are completely smooth, even those lying close to the horizontal. The familiar 'serrated' electronic lines are not visible - even in the seemingly impossible area of where lines of different colors overlap. All this is achieved with an image that is beautifully sharp and applies whatever saturation, hue and luminance level is used. The deceptively simple task of signing a name on the screen is so smooth and the realism so great, that the results are quite disarming.

However, perhaps the most striking operational difference with the Paint Box is that the stylus has 'feel' - it is pressure-sensitive. In a manner similar to a pencil, the harder the pressure on the stylus, the bolder the stroke; the lighter the pressure, the more delicate the shading. Areas covered several times with light pressure become progressively bolder - again, just like a pencil. Also, when painting, overlapping colors mix - just like oil or water color.

All functions of the Paint Box are controlled from the touch tablet. A stroke of the stylus sideways off the tablet brings up a selection menu. If painting is selected, a stroke down off the tablet with the stylus will bring up the palette. The palette consists of 20 preselect colors selected from a color bank at the start of a session, 12 empty paint pots which the artist can fill as he goes along, a color mixing area, a selection of four brush sizes and a type of brush selection.

The 20 or so basic colors on the palette are not sufficient for a full painting, so the artist has been provided with a means of mixing colors. If he dabs color onto the central area of the palette (the mixing area) then selects another color and applies a thin layer of that across the first color, the two will mix. The artist can then touch his stylus in the area where the two colors have mixed and pick up the mixed color. He can then paint with this color, or he may again apply it to the palette and mix it with another color, select the new mixture, and proceed to paint with that new color. In fact, there is no limit to the different colors which the artist may mix from the basic set. This method of color mixing applies to all brush sizes. Having mixed up a color which he likes, the artist may then put this into one of the empty paint pots for later use.

As well as being able to pick up colors mixed on the palette, the artist can also select colors from the picture itself. As the picture progresses, it becomes easier to pick up a color from the picture, perhaps modify it with some white or black to change its shade, and then continue painting in detail with this new color, while the paint pots are used less and less.

There are three modes of painting available on the system. The first operates like normal paint, in that it mixes with the base color when applied thinly and becomes completely opaque when applied thickly. The second is a form of water color. This can still be applied in a thick or thin film that always remains translucent, so that the

underlying detail is not lost. It is used for laying down transparent washes of color, either as a background, or for tinting and shading detail already drawn. The third mode adds texture to the brush in much the same way as chalk, allowing the artist to easily achieve a slightly textured effect on paintings.

The artist has on the palette all the basic tools needed to do a painting and can access them very simply. This allows him to concentrate on painting without having to think how he actually sets about operating the system. Actually, the Paint Box behaves in exactly the same way as all the elements that the artist is used to. The exercise of painting or drawing, is really very unsurprising once having overcome the initial shock that it is all done electronically, and is not wet and sticky. This total cleanliness and ease of precisely matching colors by being able to pick them up directly from the painting, increases the speed of painting considerably.

A section enlargement facility allows any area of the picture to be magnified to twice its size so that the artist can work in much greater detail on particular parts of the picture if he so wishes.

#### The Paint Box - A Retoucher's Dream

Because the Paint Box operates as a full color machine with the entire scope of the NTSC system available, it is able, in real time, to accept any RGB or NTSC video feed. The artist may freeze the image at any time and then retouch it, modify it, or augment it with graphics at will.

Since the Paint Box allows colors to be picked off the canvas as well as the palette, retouching is a dream: perfect color match occurs automatically by picking up color directly from areas adjacent to the one to be retouched.

Now, with the Paint Box, video can be retouched or modified directly without resort to the photographic process, and the quality of the resultant image allows the artist to undertake work that would be virtually impossible in the photographic medium.

#### The Paint Box - An Automatic Graphics Designer

A full automatic graphics package is included in the Paint Box. Simple routines allow straight lines, circles, ellipses, boxes, etc., to be drawn automatically and placed free-hand or against an invisible grid. With the addition of automatic color fill routines and a smooth air brush, all the normal day-to-day graphic aids an artist would want to use for the generation of TV graphics are at his fingertips.

#### The Paint Box - A Superb Character Generator

Good pictures and graphics are of little use unless top quality fonts are available for adding text.

The Paint Box has built into the library of routines available very high quality fonts with characters that can only be compared against the

finest of studio cameras viewing the best artwork.

Text may be generated in either of two ways depending on the artist's preference. Having chosen the font, he may position each character individually by means of the touch tablet (like lettraset); or he may type a string of characters using the keyboard and then position this whole string with the stylus. In the former case, character spacing is entirely at the discretion of the artist; in the latter case, proportional spacing is automatic.

Many different fonts are available with the full range of colors and with or without drop shadow.

#### The Paint Box - A Picture Library

During a normal working day the artist will have many pictures to which he may wish to refer.

The Paint Box includes a Winchester disk able to hold 300 pictures or parts of pictures. To support this facility the system has full titling and title search by keyboard. The images themselves may be browsed through against a title keyboard, 12 at a time, to remind the artist of the contents of the disk. When he finds a picture he wants he merely touches it via the stylus and touch tablet and it appears full-size ready to be worked on.

In addition to the internal library, the Paint Box can be augmented by the DLS 6000 digital library system. The DLS 6000 can be connected directly to the Paint Box via a digital link, or connected via the tape back-up system for the 6000 carrying pictures on an ordinary U-Matic cassette but in slow digital format.

Also floppy disk storage is available on a one-picture-per-disk basis.

#### The Paint Box - A Perfect Picture Assembly Aid - Cut-and-Paste

The Paint Box has a unique facility of being able to join or fuse pictures together.

The artist is able to take images he has drawn free-hand or created using the graphic routines and create a mask or key by simply drawing around the part of the picture of interest. The quality of the mask drawn with the same brushes used for painting is as good as the original video. The shape of the mask can be as complex or as simple as desired. The smoothness of the edge will be the same as the original drawing.

Once the mask has been defined, the artist can pick up the cut image with the touch tablet stylus and move it around at will - actually seeing the image move in real time.

If a different background picture is called up from the Paint Box library, then the cut image can act as foreground and move over the background just as if the cut image were against a chroma key area and keyed into the background in a switcher.

However, the magic of the Paint Box does not stop at just being able to move the cut video around. By means of a small joystick the artist is also able to change the size and aspect ratio of the cut image and rotate it.

In other words, it is as if the cut image is on a rostrum camera and the artist is able to reposition and re-orientate the artwork as well as play with the zoom lens. However, there is no camera, no zoom lens, and no artwork to curl up or get dirty.

Once the artist is happy that the position, size and orientation of the cut image is correct, he confirms that the two images are to be pasted (or fused) together. The cut image is then blended permanently into the background using the mask or key information.

Consider the preparation of standard television graphic, say a news item on the State of the Union Message. The artist could draw a free-hand sketch of the Capitol full size. He could also have in the library a real video picture of the President.

To compose the graphic he would choose a background color and the Paint Box will automatically flood the screen in this color. He then calls up the Capitol, draws around the outline he wishes to use (probably in this case with a broad soft brush to achieve a soft edge). He can reduce the size of the image, move it to a point that he likes, choose the correct orientation, and then tell the Paint Box to paste it into the background.

Next he does the same thing with the real picture of the President, noting that since the President is pasted last he can overlap the Capitol if required.

Finally, a font for the caption 'State of the Union' is chosen and the letters either pasted individually or as a complete string. The complete graphic can then be returned to the internal Paint Box library or sent to the DLS 6000 library system for on-air transmission.

An exotic use of the cut-and-paste routine is to accentuate the soft-edge mode to the point where the mask or key is not hard or solid at all. This will cause a mixing of the foreground object and the background instead of the 'fusion' described earlier.

An example of such a technique is the representation of a propeller on an airplane normally shown as semi-transparent swirls to indicate motion. Utilizing the soft key approach, the airplane itself can be cut as usual but the propeller swirls can be cut with a soft key. The resultant image when pasted up will show the airplane replacing the background. However,

the background behind the propellers will still be visible through the swirls.

The Paint Box - An Electronic Stencil

A slightly unusual application of the mask, normally used for cut-and-paste is to utilize the mask as a stencil. Coupled with the air brush routine, the results are remarkable: the exact electronic equivalent of a stencil and spray gun.

**CERTIFICATE OF SERVICE**

I, Julia Heaney, hereby certify that on May 31, 2006, I caused to be electronically filed the foregoing with the Clerk of the Court using CM/ECF, which will send notification of such filing(s) to the following:

Paul M. Lukoff, Esquire  
David E. Brand, Esquire  
Prickett, Jones & Elliott, P.A.

and that I caused copies to be served upon the following in the manner indicated:

**BY HAND**

Paul M. Lukoff, Esquire  
Prickett, Jones, Elliott, P.A.  
1310 King Street  
Wilmington, DE 19899

**BY FEDERAL EXPRESS**

Michael J. Summersgill, Esquire  
Wilmer Cutler Pickering Hale and Dorr LLP  
60 State Street  
Boston, MA 02109

/s/ Julia Heaney  
Julia Heaney (#3052)